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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,732	07/22/2002	Karl Heinz Schmid	C 2078 PCT/US	4550

23657 7590 06/29/2004

COGNIS CORPORATION
PATENT DEPARTMENT
300 BROOKSIDE AVENUE
AMBLER, PA 19002

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,732

Applicant(s)

SCHMID ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/25/02</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claims 13-27 are pending. The Preliminary Amendment filed 9/15/00, cancelled claims 1-12 and added claims 13-27.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burns (DCI) in combination with Kahre et al. (6,432,419).

The instant invention is directed toward a composition comprising an alkyl and/or alkenyl oligoglycoside, a foam stabilizer selected from a partial ester of tartaric acid, malic acid, citric acid, and/or their salts, and mixtures thereof; and optionally, an active ingredient, wherein the ratio of oligoglycoside to stabilizer is from about 60:40 to 40:60, and methods of enhancing mucous membrane compatability.

Burns teaches ultra mild naturally derived surfactants, wherein the surfactants are alkyl oligoglycosides combined with partial esters of tartaric acid/citric acid sodium salts. Exemplified are cosmetic compositions containing 2.2-18.5% of these surfactants. The combination of partially esterified salt forms of tartaric and citric acid are taught as ultra-mild

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surfactants that foam well and effectively cleanse in cosmetic compositions. The reference lacks the ratio of oligoglycoside to foam stabilizer recited in the claims. See page 42-51 and 96.

Kahre et al. disclose in a cosmetic composition a nonionic surfactant selected from alkyl or alkenyl oligoglycoside and a fatty compound of hydroxycarboxylic acid esters wherein said fatty compound and nonionic surfactant are present in a ratio by weight of 10:90 to 90:10, and preferably a ratio of 40:60 to 60:40, see Col. 9, lines 20-59 and lines 56-57. For malic, tartaric, and citric acid, see Col. 3, lines 15-35. For surfactant mixture amounts, see Col. 8, lines 15-16. The reference teaches that by employing the compounds in such a ratio, the sensorial properties of the fatty compounds are further improved, see Col. 3, lines 35-44. The reference lacks partially esterified and salt forms.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify the oligoglycoside to tartaric partial ester salt, using the teachings of Burns et al., to have the ratio recited in the instant claims a) because Kahre et al. teach that combining fatty compound (tartaric acid) and nonionic surfactant (oligoglycoside) in a ratio of 40:60 to 60:40 results in a product with improved sensorial properties; b) because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. Thus, one of skill would be motivated to formulate the oligoglycoside to foam stabilizer in the ratio recited in the instant claims because of the expectation of achieving the mildest surfactant that imparts improved sensorial properties to the user.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the tartaric, malic and citric acids of Kahre et al. as partially esterified salts because of the expectation of achieving a product with little irritation to the skin.

It is respectfully pointed out that instant claims 14-15, 17-18, 20-21, and 23-24 are product-by-process claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Claims 19-27 are directed to a method of enhancing the dermatological and ophthalmic mucous membrane compatibility of a cosmetic and/or pharmaceutical composition by adding the surfactant mixture to the composition. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches adding to cosmetic compositions for dermatological use, surfactant mixtures containing the same components as instantly claimed, which would inherently enhance the dermatological and ophthalmic mucous membrane compatibility of a cosmetic/pharmaceutical composition, as instantly claimed.

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Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

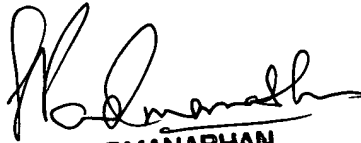
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER